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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,596	02/12/2001	Ian Robinson	32093.00006	6793

7590

07/24/2003

Squire, Sanders & Dempsey L.L.P.
Two Renaissance Square
Suite 2700
40 North Central Avenue
Phoenix, AZ 85004-4498

EXAMINER

JOLLEY, KIRSTEN

ART UNIT

PAPER NUMBER

1762

DATE MAILED: 07/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-11

Advisory Action	Application No. 09/781,596	Applicant(s) ROBINSON, IAN	
	Examiner Kirsten Crockford Jolley	Art Unit 1762	

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 15 July 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See attached Action.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 23-33.

Claim(s) withdrawn from consideration: 10,18-22.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

ADVISORY ACTION

1. The proposed amendments will not be entered because they raise issues that would require further consideration and/or search, because they present an additional claim without canceling a corresponding claim, and because they do not materially reduce or simplify the issues for appeal. Specifically, the proposed limitation to be added to claim 23 requiring that the coating is suitable for contact with drinking water would require further consideration and/or search. Also, new claim 34 would require further consideration and/or search. The Examiner notes that if the proposed amendments to claims 24, 25, 27, 30, and 31 are supplied separately in a new After-final amendment, those proposed amendments would be entered.

2. Applicant argues that the combination of the coating from EP '728 and the application method of EP '235 fails to teach or suggest the coating is suitable for contact with drinking water; nothing in EP '728 indicates it can be used in drinking water pipelines or that it has been tested in drinking water pipes. Additionally, Applicant argues that the use of filler material or chemical sizing could have a detrimental effect on drinking water quality or the ability of the coating to stay together in water. The Examiner notes that this newly proposed limitation would require further consideration and/or search, and therefore has not been entered. The Examiner also notes that the chemically sized filler material in the invention of EP '728 is used to provide abrasion resistance to the coating, and in the case where abrasion resistance is not desired in the final coated product, it would have been obvious for a skilled artisan to have omitted the filler material with the subsequent expectation of a loss of abrasion resistance in the coating material.

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3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten Crockford Jolley whose telephone number is 703-306-5461. The examiner can normally be reached on Monday to Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1193.

kcj

July 22, 2003


SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700